

has two major opposing surfaces and can be employed for printing on both surfaces as described at column 11, lines 6-8 of the reference. However, this is a general description that has been described in other publications than Anderson, the disclosure being known in the present art, and has very little significance to the specific features of the presently claimed invention, such as recited in claim 1.

The applicants have carefully explained in the previous responses filed in this application on June 16, 2004 and December 8, 2003, that the present invention cannot be accomplished by the general description of Anderson to 1) select a transparent support, and to 2) select the present ink-receptive layers, there being on both surfaces of the support, and the aforesaid features being in combination with one another. Only hindsight would lead a person of ordinary skill in the art to the present invention.

For example, a substrate to be used for providing ink-receptive layers on both surfaces thereof is an opaque support such as the paper disclosed in, for example, technical reference U.S. Patent No. 6,432,550, a copy of which is attached to this Response, with PTO Form 1449 listing same. In U.S. Patent No. 6,432,550, a cationic compound is contained in the ink-receptive layers on both surfaces of the substrate, and an opacity of the substrate is defined to be 94% or more so as to prevent a printed image of the ink-receptive layer at the opposite surface.

The technical reference, U.S. Patent No. 6,432,550 and prior art references cited therein or described therein, i.e., Japanese Laid-Open Patent Publications No. 56-148584, 2-270588, 8-174996 and 9-286166 all relate to inventions in which ink-receptive layers are provided on the both surfaces of an opaque paper support.

Anderson does not provide teachings that would lead a person of ordinary skill in the art to the presently claimed invention.

The teachings of Ishii et al. do not remedy the deficiencies of Anderson et al. The invention disclosed in Ishii relates to a recording material having an ink receiving layer on a substrate in which the ink receiving layer contains microparticle silica and a binder resin with a specific ratio and contains a dicyandiamide polycondensate. The description noted in the Office Action at paragraph [0034] describes a decrease in opacity of the ink receiving layer by using microparticle silica. Accordingly, the ink receiving layer is preferably defined to be an opacity of 35% or less measured by a measurement method according to JIS-P8138 when the ink receiving layer is provided on a transparent PET substrate having an opacity in the range of 13.0 to 16.0%. Thus, this does not mean that the ink receiving layer is provided on the transparent PET substrate to prepare the recording material of Ishii.

This is because, the substrates to be used in the recording material of Ishii are disclosed to be a paper substrate as described at the paragraph [0032] on page 2, right column of Ishii. Also, the substrates used in the working Examples described at page 3, right column, paragraph [0044] to page 5, left column, are all paper substrates, so that the opacity of the recording material can be understood to be quite high. Moreover, there is no description about a back-coating layer in Ishii.

The applicants submit that a person of ordinary skill in the art would not be led to combine the teaching of the secondary reference, Ishii et al. with the teachings of Anderson. There is no teaching or motivation to combine the references to result in the presently claimed invention. The applicants submit that the combination is not tenable and should be withdrawn.

Even if the combined teachings of the references were considered then such combination would not make the presently claimed invention to be obvious for the several reasons discussed above.

Finally, please note that in the present application, the claimed priority date of February 16, 2001, is earlier than the filing date of Ishii et al., April 19, 2001. Thus, in any event, the citation of Ishii et al. is not appropriate and would be withdrawn, if necessary upon perfection by the applicants of the priority claim.

The presently claimed invention is no where described, suggested or made obvious by the teachings of the cited references. The presently claimed invention is fully allowable under Section 103(a) in view of the prior art.

In view of the above and the attached document, the applicants submit that this application is in condition for allowance and a Notice to that effect is respectfully requested.

Respectfully submitted,

Manelli Denison & Selter, PLLC

By Paul E. White, Jr.

Paul E. White, Jr.

Reg. No. 32,011

Tel. No.: (202) 261-1050

Fax No.: (202) 887-0336

2000 M Street, N.W.
Seventh Floor
Washington, D.C. 20036
(202) 261-1000

NAGASHIMA et al. – Appln. No. 10/073,213
This paper filed June 30, 2005



TECHNICAL REFERENCE